

Application No: 09/914,828
Amendment dated: October 22, 2003
Reply to Office Action of July 22, 2003

REMARKS

Initially, the undersigned attorney would like to thank the Examiner for the courtesies extended to him in a telephone interview on October 14, 2003, regarding the pending Office Action. In that interview, the Examiner's position with respect to the prior art reference, Sherman U.S. Patent No. 468,398, and how it anticipates the present invention was questioned, particularly with respect to claim 1. The Examiner explained his position, and although the Applicant respectfully disagrees with the Examiner's position as set forth hereinbelow, his position is now understood.

Similarly, the undersigned attorney initially did not understand the Examiner's position on the restriction requirement. During the interview however, the undersigned attorney reread the Examiner's comments thereon and acknowledged that he now understood the Examiner's position. Contrary to the Examiner's Interview Summary however, the undersigned attorney did not agree that the restriction of claim 16 was proper. Instead, the undersigned attorney only acknowledged that he now understood why the Examiner was making the restriction. As noted below, the Applicant traverses the restriction for reasons as follows

The Examiner has restricted the invention to one of two groups – claims 1-15 (Group I) drawn to the saddle, and claim 16 (Group II) drawn to a pedal-operated machine and the saddle. The Examiner asserts that the inventions of Group I and II are related as combination and subcombination and, in the instant invention, the combination as claimed does not require the particulars of the subcombination because the combination is also directed at pedals.

The Applicant confirms the election of Group I, claims 1-15, for this restriction requirement. However, Applicant respectfully traverses this restriction requirement on the basis that the combination as claimed does require the particulars of the subcombination as claimed. With respect to the Examiner's assertion that the combination includes pedals, the Applicant notes that the subcombination claim 1 is for a "saddle for a pedal-operated machine." Therefore, pedals will also be a part of the

pedal-operated machine. Otherwise, claim 1 would simply claim a saddle, but it does not. Since the rest of the claim 16 is identical in structure to claim 1, it is believed that the Examiner has improperly restricted claim 16 from claims 1-15. Accordingly, the Applicant respectfully request the Examiner to reconsider the restriction requirement in light of the foregoing and to withdraw the restriction requirement.

Turning to the prior art rejections, the Examiner has again rejected claims 1-3 and 12-14 under 35 U.S.C. §102(b) as being anticipated by the Sherman patent noted above and rejected claim 15 under 35 U.S.C. §103(a) as being obvious over the Sherman patent. In conjunction therewith, the Examiner again asserts that Sherman discloses a saddle having a seat portion (a) with an upper surface and a mounting arrangement to allow lateral rocking motion. To the argument made by Applicant in his prior response that Sherman has an effective pivotal axis that is located **below** the upper surface of the seat portion of the saddle while the present invention's effective axis is above the upper surface of the seat portion, the Examiner is now understood to assert that, because Applicant allegedly "has not clearly defined the axis of orientation of the seat," the saddle may be turned upside down so that the effective pivotal axis in Sherman is "above the seat portion," based upon the Examiner's interpretation.

The Applicant respectfully disagrees. While it is true that the Examiner may base his argument on the broadest reasonable interpretation permitted by the claims, his interpretation, *i.e.*, turning the saddle upside down, is simply not a *reasonable* interpretation. The rejected claims are directed toward a saddle for a pedal-operated machine. Thus, to pedal the machine, common sense dictates that since the machine has a saddle and, more particularly, a seat portion, the user of the machine must use his legs to pedal operate the machine. Otherwise, the seat portion has no operative function or utility.

Moreover, as clearly defined in claim 1, the seat portion has an upper surface *for supporting the buttocks of the user*. In the interview with the Examiner, he asserted that this is merely functional language. Applicant disagrees. The above-

emphasized language shows a structural relationship between the user of the saddle and the saddle itself, and in this instance, more importantly, a relationship defining which surface of the seat portion is being identified -- that upper surface which supports the buttocks.

Now, according to the Examiner, one can simply turn the *seat* upside down ("rotated 180 degrees") and meet the language of the rejected claims. Applicant disagrees. First, to turn the seat upside down, the entire saddle will have to be turned upside down. Otherwise, the seat will not be capable of being mounted. In doing so, the saddle is then inoperable inasmuch as the user cannot sit his buttocks on the upper surface. In other words, the saddle is inoperable in the configuration suggested by the Examiner. The user will not be using any saddle for a pedal-operated machine where the seat the user is to sit upon is upside down.

Still further, Applicant notes that the claims require an *upper* surface. Turning the seat upside down now makes the upper surface a lower surface because, without any axis of orientation as suggested by the Examiner, the word "upper" must necessarily be oriented with respect to the ground or lay of the land. To the extent the Examiner further argues that "the upper surface" can then become that surface contacting the mounting arrangement, Applicant submits that this orientation is also nonsensical since that upper surface would not support the buttocks of the user. Again, the entire phrase "upper surface for supporting the buttocks of a user" shows a structural relationship and orientation of the seat portion of the saddle, and any different interpretation as to the axis of orientation is simply not reasonable and lacks common sense.

Notwithstanding the above, in order to aid the Examiner in his interpretation of the claims, Applicant has amended claim 1 and withdrawn claim 16 to indicate that the mounting arrangement is below the seat portion. With this amendment, the Examiner will appreciate that the claim 1 can no longer meet his interpretation. If the seat is turned upside down, the mounting arrangement is also

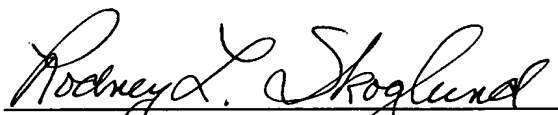
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turned upside down in order for the saddle in Sherman to remain operable. In doing so, the mounting arrangement in Sherman is then above the seat portion in contravention of the claims.

Applicant believes the interpretation that the mounting arrangement is below the seat portion should have been clearly interpreted from a fair reading of the claims based upon the common definition of the word "upper" and the phrase "upper surface for supporting the buttocks of a user," but nevertheless has provided this amendment in order to satisfy the Examiner's interpretation of the claims. As Applicant has been made this amendment only to avoid further issues of interpretation, it is not seen as raising any new issues for the claims. Given a reasonable interpretation in the first instance, the claims should have been allowable over Sherman and any other prior art.

Therefore, Applicant respectfully requests the Examiner to reconsider the application, withdraw the restriction requirement, and withdraw his rejection of claims 1-3 and 12-15. A Notice of Allowance of claims 1-16 is earnestly solicited. Should the Examiner care to discuss any of the foregoing in greater detail, the undersigned attorney would welcome a telephone call.

Respectfully Submitted,



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